

Appl. No. 10/758,435
Resp./Amdt. dated Sep. 15, 2005
Reply to Office Action of 06/22/2005

REMARKS/ARGUMENTS

There are no amendments to the specification, drawings or claims herein.

Claims 1-35 remain and are pending in the application. Claims 1-34 are rejected and Claim 35 is objected to. Reconsideration is respectfully requested.

The Examiner provisionally rejected Claims 1, 3-7, 10, 12-18, 20-24, 27 and 32-34 under 35 U.S.C. 101 as claiming the same invention as that of Claims 1-13, 15-20, 24 and 28-30 of copending Application No. 10/368,179 (hereinafter 'Copending Application'). Applicant respectfully traverses the rejection for lack of *prima facie* support thereof. In particular, the instant application fails to claim the "same invention" (i.e., identical subject matter) as is claimed in the Copending Application. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1984); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957).

In rejecting a claim under 35 U.S.C. 101 as claiming the same invention (i.e., 'same-invention double patenting'), the Examiner must determine whether a claim in the instant application could be literally infringed without literally infringing a corresponding claim in the patent or patent application employed in the rejection. In other words, as stated in the MPEP, Section 804 (II)(A), *Statutory Double Patenting - 35 U.S.C. 101*, "[i]s there an embodiment of the invention that falls within the scope of one claim, but not the other? If there is such an embodiment, then identical subject matter is not defined by both claims and statutory double patenting would not exist". The MPEP (cited *supra*) suggests an example in which a subject claim recites "halogen" and the corresponding claim recites "chlorine". Since the subject claim to "halogen" embraces embodiments that include bromine, for example, the subject claim and the corresponding claim do not and cannot recite identical subject matter. Thus, these exemplary claims fail to meet the test for "same invention" double patenting under 35 U.S.C. 101.

Regarding the instant application, each of the claims rejected under 35 U.S.C. 101 for same invention variously recite or are dependent from a claim that recites a "multiport vector network analyzer". The term "multiport vector network analyzer" as defined and employed by Applicant is a vector network analyzer, "having more than two test ports" (See Applicant's specification, Page 5, line 31). Moreover, at

Appl. No. 10/758,435
Resp./Amdt. dated Sep. 15, 2005
Reply to Office Action of 06/22/2005

least rejected base Claims 10, 18, 24 and 32 variously recite "a multiport vector network analyzer having more than two ports".

Claims 1-13, 15-20, 24 and 28-30, of the Copending Application recite "a vector network analyzer", an embodiment of which is a "two-port" vector network analyzer. See for example, Copending Application, Figure 6. The claims of the Copending Application clearly embrace an embodiment (e.g., a two-port vector network analyzer) that is not a "multiport vector network analyzer", as defined by Applicant and claimed in the instant application. As such, and without more, Claims 1, 3-7, 10, 12-18, 20-24, 27 and 32-34 do not and cannot recite the "same invention" as recited in the corresponding claims of the Copending Application. Reconsideration and withdrawal of the rejection of Claims 1, 3-7, 10, 12-18, 20-24, 27 and 32-34 under 35 U.S.C. 101 is respectfully requested for lack of *prima facie* support.

The Examiner provisionally rejected Claims 2 and 11, Claims 8, 9, 19 and 25, Claim 26, and Claims 28-31, under the judicially created doctrine of obviousness-type double patenting in view of the Copending Application and Ferrero et al., "Comparison Between a Vector Multi-port Network Analyzer and the National S-Parameter Measurement," IEEE Article, TU2B-2, January 1995, pp. 143-144, (hereinafter 'Ferrero et al.').

Applicant submits herewith as Appendix A (2 pages, 2 copies), a *Terminal Disclaimer Responsive to a Provisional Double Patenting Rejection* (hereinafter 'Terminal Disclaimer'). The Terminal Disclaimer authorizes the Commissioner for Patents to charge the deposit account of Agilent Technologies, Inc. for the fee under 37 CFR 1.29(d) and is submitted in duplicate for that purpose. Applicant respectfully submits that the Terminal Disclaimer renders moot the Examiner's provisional obviousness-type double patenting rejection of Claims 2 and 11, Claims 8, 9, 19 and 25, Claim 26, and Claims 28-31. Reconsideration and withdrawal of the rejection are respectfully requested.

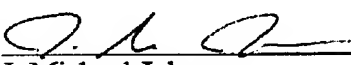
Applicant appreciates the Examiner's acknowledgement of the allowability of Claim 35 if re-written in independent form. However, in light of the arguments presented above regarding Claims 32-33, from which Claim 35 is dependent, Applicant respectfully declines to re-write the claim at this time and respectfully requests reconsideration.

Appl. No. 10/758,435
 Resp./Amdt. dated Sep. 15, 2005
 Reply to Office Action of 06/22/2005

In summary, Claims 1-35 are pending. Claims 1-34 were rejected and Claim 35 was objected to. As detailed hereinabove, Claims 1-34, along with Claim 35, are in condition for allowance. A Terminal Disclaimer (2 pages, 2 copies) accompanies this Response/Amendment as Appendix A for consideration. It is respectfully requested that Claims 1-35 be allowed, and that the application be passed to issue at an early date.


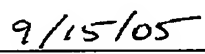
Should the Examiner's action be other than allowance, the undersigned respectfully requests a telephone call from the Examiner to discuss further consideration that would expedite the prosecution of the application. Moreover, should the Examiner have any questions regarding the above, please contact the undersigned, J. Michael Johnson, telephone number (775) 849-3085, or John L. Imperato, Attorney for Applicant, Registration No. 40,026 at Agilent Technologies, Inc., telephone number (650) 485-5511.

Respectfully submitted,
 TIBERIU JAMNEALA ET AL.

By: 
 J. Michael Johnson
 Attorney/Agent for Applicant(s)
 Registration No. 37,856
 (775) 849-3085

CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office on the date shown below.

 
 J. Michael Johnson Date

* * *